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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/209,706 12/11/98 TOKAS E IR-2588(ET)

IM62/0912

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EXAMINER

KNABLE, G

ART UNIT

PAPER NUMBER

1733

8

DATE MAILED:

09/12/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/209,706

Applicant(s)

Tokas et al.

Examiner

Geoffrey L. Knable

Group Art Unit

1733



☒ Responsive to communication(s) filed on Jun 30, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-99 is/are pending in the application.

Of the above, claim(s) 1-52, 84-92, 95, and 97 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 53-83, 93, 94, 96, and 98 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Applicant's election of group II in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-52, 84-92, 95 and 97 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 7.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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5. Claims 53, 54, 58, 59, 60-63, 65, 66-71, 75, 76 and 83 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the article of Weck et al. (cited by applicant) or the article of Bartz et al. (cited by applicant).

Each of these articles teaches applying a catalyst to a substrate surface prior to application of a metathesizable polymer, this polymer forming a coating on the surface. The references further would seem to suggest materials consistent with each of the noted claims, any differences being mere routine and obvious optimizations.

6. Claims 53-55, 58-63, 66 and 71-82 rejected under 35 U.S.C. 102(b) as being anticipated by EP 424,833 to BF Goodrich.

EP '833 teaches providing a substrate coated with a catalyst and then introducing the metathesizable polymer into contact with the substrate. Although this reference is principally directed to providing the substrate as a reinforcement for the polymer, nothing in the present claims defines over this, it being considered that the substrate is clearly coated with the polymer material. The specifics of the noted claims are also considered to be clearly taught by the reference. As to claim 63, when the catalyst is applied to the substrate, the catalyst can reasonably be considered to be then part of the substrate.

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7. Claims 67-71, 83, 96 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 424,833 to BF Goodrich.

Although this reference does not explicitly define the claimed ruthenium based or other catalysts, the reference does suggest that any conventional catalyst used in the bulk polymerization is suitable. As it is considered that the claimed materials are known and conventional per se as catalysts of the metathesis polymerization, it would have been obvious to also utilize such materials, only the expected results being achieved.


8. Claims 53-83, 93, 94, 96 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO97/38036 to Ciba Specialty Chemicals taken in view of EP 424,833 and optionally the articles of Weck et al. (cited by applicant) and Bartz et al. (cited by applicant).

WO 97/38036 is exemplary of the known application of metathesis polymerizable materials as coatings on a wide variety of substrates - note particularly pages 33+. The reference however seems to principally either only describe the coatings in general or to indicate that the polymer is applied together or already mixed with the catalyst. EP '833 is also directed to metathesis polymerization and in particular indicates that the need for a separate mixing of the monomer with a catalyst stream

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can be obviated if the catalyst is first applied to the substrate surface. The two cited articles seem to suggest similar application of the catalyst to the surface rather than in mixture with the monomer. It would have been prima facie obvious to apply the catalyst to a surface being coated rather than in mixture with the monomer in light of these teachings, none but the expected results would be achieved. The particular catalysts and monomers claimed are considered to be well known, conventional and therefore obvious in the art of metathesis polymerization.

9. Any inquiry concerning this communication should be directed to Geof Knable at telephone number (703) 308-2062. The fax phone numbers for Art Unit 1733 are (703) 305-3599 for Official After Final faxes and (703) 305-7718 for all other Official faxes.

  
GEOFFREY L. KNABLE  
PRIMARY EXAMINER  
GROUP 1700

G. Knable  
September 11, 2000